

### **REMARKS**

Claims 1 through 22 have been canceled.

Claims 23 through 31 are pending.

Examiner has rejected claims 23 through 31 under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,785,724 (Drainville) in view of USPN 6,317,831 (King). Applicant respectfully traverses the rejection and requests reconsideration.

### **Response to New Arguments Raised by Examiner**

#### **Portable Computer:**

Examiner has argued as follows:

Remote device is an on-demand web server. Although it is not intended to be moved often, the computer is still portable because it is capable of being moved.

The term "portable computer" is well understood in the art. For example, the specification specifically sets out a definition for "personal computer" that is commonly recognized in the art.

Particularly, the Specification at page 1, lines 5 through 7, gives the following definition: "What is meant by a portable computer herein is any computing system that is easily transportable by a user and can be run by an included battery or batteries."

Examiner has ignored the given definition of "portable computer" and redefined portable computer to be any computer that is capable of being moved. By Examiner's definition every computer is a portable computer because every

computer is capable of being moved. Even the world's largest mainframe computer fits under Examiner's definition of portable computer, because, while not intended to be moved often, such a computer is capable of being moved. Thus, Examiner has redefined the term "portable" to have no meaning at all, but to be a completely meaningless and redundant when used with together with the term "computer".

Redefining words to have no meaning is not a proper method of evaluating a limitation in a claim. Rather, words should be understood in the light of common usage and in light of usage in Applicant's Specification.

Further, if there is any dispute about the meaning of words, the Applicant (not the Examiner) is allowed to clarify the meaning of words. In fact, the courts have consistently indicated that an inventor may be his own lexicographer. See, for example, *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 U.S.P.Q. 90 (Fed. Cir. 1985); and, *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 U.S.P.Q. 2d 1557 (Fed Cir. 1988). A patentee may be his own lexicographer and grammarian. He "may define his own terms regardless of common or technical meaning....Fairness to any patentee requires a court to accept his definition of words, phrases and terms." "Claim language is not to be interpreted in a vacuum but is to be read in light of the specification to determine the meaning intended by the inventors." *Rohm & Haas Co. v. Dawson Chemical Co., Inc.*, 557 F. Supp 739, 217 U.S.P.Q. 515, 573 (Tex. 1983).

Applicant has made very clear in the Specification what is meant by the term "portable computer". The term is specifically defined in the Specification. It

is inappropriate, therefore, for Examiner to redefine the term “portable computer” so that the word “portable” is redundant and has no meaning.

**Drainville does not disclose a wireless tap from a client:**

Examiner has argued as follows:

Drainville teaches being awakened in response to a wireless tap (column 6, lines 9 through 13) from a client. Drainville does not teach that client being a personal digital assistant. King teaches a personal digital assistant which is capable of wireless communication and could be used as a client. Thus the combination of Drainville and King teach the computer being awakened in response to a wireless communication from a personal digital assistant.

Examiner has misread Drainville. Specifically, Examiner has asserted “Drainville teaches being awakened in response to a wireless tap (column 6, lines 9 through 13) from a client.” This is an incorrect reading of Drainville.

At column 6, lines 9 through 13, Drainville teaches that application module 46 can use a phone tap or equivalent to alert on-demand web server 22 to get on line. However, application module 46 is not part of client 10. Rather, application module 46 is associated with tapping web server 30 and is located within the wired network of corporate facility 34. See Drainville at Figure 2A and column 5, lines 53 through 56. Column 6, lines 9 through 13 does not disclose or suggest that client 10 performs a wireless tap, does not disclose or suggest that client 10 engages in wireless communication with remote device 22 and does not disclose or suggest that client 10 could be a personal digital assistant.

Based on this incorrect reading Drainville, Examiner has argued that merely replacing client 10 in Drainville with a personal digital assistant discloses

the subject matter of the claims. This is clearly not the case. Drainville does not disclose or suggest that client 10 has any wireless communications with remote device 22; therefore, replacing client 10 in Drainville with a PDA, does not result in the disclosure of any of the subject matter set out in the claims.

### **Full Discussion of Rejection**

#### **Criteria for a Rejection under 35 U.S.C. § 103(a)**

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there are claim limitations that are not taught or suggested by any of the cited references. Further, Examiner has failed to provide an adequate suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Drainville in light of King. Below, Applicant discusses limitations in the independent claims 23, 26 and 29 not disclosed or

suggested by the cited art. On the basis of this, Applicant believes all the claims are patentable over the cited art.

Independent Claim 23:

Independent claim 23 sets out a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant. None of the cited art discloses or suggests a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant.

**Drainville:**

Examiner has asserted that remote device 22 shown in Figure 1 of Drainville is a portable computer. However, nothing in Drainville discloses or suggests that this is so. In fact, Drainville teaches away from remote device 22 being a portable computer. Specifically, remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. It is clear from this teaching of Drainville that Drainville is not disclosing or suggesting that remote device 22 is a portable computer, but rather is specifically disclosing that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through a modem.

Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not disclose or

suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 23, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital assistant. A response is generated and the response is transmitted via another wireless communication transmission.

This is not disclosed or suggested by Drainville. Particularly, Drainville teaches that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. Thus Drainville does not disclose or suggest transmission of responses from a portable computer via wireless communication transmission. Rather, Drainville teaches that on-demand web server 22 responds to requests via wired connections through a modem.

At column 6, lines 8 through 13, Drainville suggests that an application web server 46 within a tapping web server 30 can perform a "phone tap" of on-demand server 22. The phone tap can be delivered through a wireless cell phone.

**King:**

Examiner has argued that King discloses wireless communications from a personal digital assistant and could be used as a client. However, Drainville does not disclose or suggest client 10 in wireless communication with on demand web server 22. It is tapping web server 30 that performs the phone tap. Substituting a personal digital assistant for client 10 would not disclose the subject matter set out

in the claims as Drainville does not disclose or suggest client 10 being in wireless communication with any entity.

**Modification of Drainville by King:**

Examiner has asserted that an advantage of the system taught by King is a quickly achieved secure connection (column 4, lines 61 through 66). Examiner has argued that it would have been obvious to one of ordinary skill in the art at the time of invention to modify Drainville by King. Motivation to combine is the ability to quickly create a secure connection.

The motivation offered by Examiner for modifying Drainville in light of King is insufficient and not really applicable to the situation of Drainville. Drainville does not disclose or suggest that client 10 performs any wireless communication. Therefore, there appears to be no motivation to replace client 10 with a personal digital assistant that has wireless security.

Further, Drainville discloses tapping web server 30 communicating with web server 22 using a phone tap. The phone companies go to great lengths to provide desired security levels to users, and there is nothing in Drainville or King that would suggest that the security scheme set out in King would provide any better security than is already available in phone systems, or even be applicable in a phone application. Nothing in Drainville or King would suggest the advantage (or the feasibility) of replacing web server 30 located within the wired network of corporate facility 34 with a PDA.

### Independent Claim 26:

Independent claim 26 sets out a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant. None of the cited art discloses or suggests a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant.

### **Drainville:**

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Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not disclose or suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 26, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital



assistant. Drainville does not disclose or suggest a portable computer being awakened from the sleep mode in response to the wireless communication from a personal digital assistant.

In independent claim 26, an action is performed in response to the wireless communication by the personal digital assistant. Drainville does not disclose or suggest an action being performed in response to a wireless communication by a personal digital assistant.

**King:**

Examiner has argued that King discloses wireless communications from a personal digital assistant and could be used as a client. However, Drainville does not disclose or suggest client 10 in wireless communication with on demand web server 22. It is tapping web server 30 that performs the phone tap. Substituting a personal digital assistant for client 10 would not disclose the subject matter set out in the claims as Drainville does not disclose or suggest client 10 being in wireless communication with any entity.

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#### Independent Claim 29:

Independent claim 29 sets out storage media storing software which when executing on a portable computer performs a method by which the portable computer responds to a wireless communication from a personal digital assistant. None of the cited art discloses or suggests a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant.

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Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not disclose or suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 29, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital assistant. Drainville does not disclose or suggest a portable computer being awakened from the sleep mode in response to the wireless communication from a personal digital assistant.

In independent claim 29, an action is performed in response to the wireless communication by the personal digital assistant. Drainville does not disclose or suggest an action being performed in response to a wireless communication by a personal digital assistant.

**King:**

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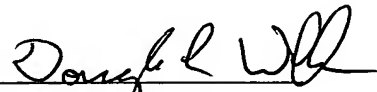
provide desired security levels to users, and there is nothing in Drainville or King that would suggest that the security scheme set out in King would provide any better security than is already available in phone systems, or even be applicable in a phone application. Nothing in Drainville or King would suggest the advantage (or the feasibility) of replacing web server 30 located within the wired network of corporate facility 34 with a PDA.

### Conclusion

Applicant believes that this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

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